

REMARKS

Claims 1-18 are pending in the present application. Claims 1-5, 7, 9, 10, 11, 14 and 16 have been amended without prejudice, Claims 6, 8, 12, 13, 15, 17 and 18 have been cancelled without prejudice, and Claims 19-23 have been added, leaving Claims 1-5, 7, 9, 10, 11, 14, 16 and 19-23 for consideration upon entry of the present Amendment. As support for the amendments is found in the specification, drawings, and claims, as originally filed, no new matter is presented in the amendments. Reconsideration and allowance of the claims is respectfully requested in view of the following remarks.

Claim Rejections Under 35 U.S.C. § 112

Claims 4, 5, and 10-18 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.

More particularly, the Examiner has argued that Claims 4 and 5 refer back to previously claimed slotted assembly and securing means. However, these features have been claimed in the alternative, and therefore, have not definitely been set forth. Applicant has amended Claims 4 and 5 to overcome this rejection.

The Examiner argues that Claim 10 is unclear because it sets forth a "jamb". However, according to the Examiner, a jamb according to the specification is the frame where a door, window, or similar opening appears. Furthermore, claim 14 sets forth that the "level" is for use with a jamb. The Examiner, argues, therefore, that it appears that the jamb is not meant to be claimed in claim 10.

Claim 10 is drafted to claim an apparatus comprising both two levels and a jamb, wherein the levels are used to install the jamb to a wall. Those claims that depend from independent Claim 10 have been amended to clarify that the jamb is intended to be included in the apparatus claim.

Based on these amendments, Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 112 rejections.

Claim Rejections Under 35 U.S.C. § 102

Claims 1-4 and 6-9 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 2,332,347 to Schaefer et al. ("Schaefer"). The Examiner argues that Schaefer discloses the invention as claimed where: 1,6 are a horizontal component/connector which are first and second overlying members with an adjustor element with a member 12 that can be loosened for easterly/westerly adjustment; 14 are vertical components that join to the horizontal component; the device may be connected to a jamb, in which case it will square, level and plumb the jamb; 12 can also be considered to be a handle, since the device can be gripped by this member; 5, 20 are levels. Applicant respectfully traverses this rejection.

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Varient, Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Independent Claim 1, from which Claims 2-4 and 6-9 depend has been amended to set forth a level comprising horizontal component having an adjustable length, wherein the horizontal component comprises three parts: (1) a first overlying member; (2) a second overlying member; and (3) an adjustor means. The adjustor means connects the first overlying member at one end of the adjustor means, and connects the second overlying member at an opposite end of the adjustor means. Therefore, in order to anticipate the claimed invention, Schaefer must, at the very least, teach or suggest all of these claim elements.

Referring to Figure 1, Schaefer teaches a beam 1 having a dovetail groove or channel 3 extending longitudinally into a portion of beam 1. The groove 3 is adapted to slidably receive an extension bar 6. Therefore, unlike Applicant's claimed invention which sets forth three different components for extending the length of the horizontal component, Schaefer teaches only two components. Accordingly, Schaefer does not teach all of the claimed elements of Applicant's claimed invention, and, therefore, cannot anticipate the claimed invention. Applicant, therefore, respectfully requests reconsideration and withdrawal of this rejection.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 10-13 and 15-18 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Schaefer. Applicant respectfully traverses this rejection.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Establishing a prima facie case of obviousness requires that all elements of the invention be disclosed in the prior art. *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A 1970).

Independent Claim 10, from which Claims 11-13 and 15-18 depend, sets forth in part:

a slotted assembly positioned on at least one of the first, second, third, and fourth vertical components, wherein the slotted assembly comprises:

a tab comprising:

a body having a length that extends transversely across and over a surface of the vertical component such that the tab protrudes over the respective abutting vertical side of the jamb; and

a slot extending along a portion of the length of the body; and

an adjustor element slidably engaged with the slot, wherein the adjustor element can be loosened to allow the tab to be slidably moved across the vertical component, the vertical side of the jamb, and across an adjacent area of wall to which the jamb is installed, and further wherein the adjustor element can be tightened to hold the level in position on the jamb.

Therefore, in order to establish a prima facie case of obviousness, Schaefer must, at the very least, teach or suggest this claim element.

Referring to Figure 1, Schaefer teaches braces 16 having one end pivotally secured, as at 17, to the beam 1 and the bar 6 adjacent the arms 14. The other end portions of the braces 16 are adjustably secured to the arms 14 through the medium of pin and slot connections 18. Therefore, Schaefer teaches braces that are connected to both

the vertical component and the horizontal component of the combination tool such that the angle between the horizontal component and the vertical component can be adjusted.

Independent Claim 10, and those claims dependent therefrom, however, sets forth a slotted assembly that attaches to the vertical component(s) of the level. The slotted assembly comprises a tab that slides across the respective vertical component such that the tab can be fitted over a vertical side of the jamb that abuts the vertical component. By maneuvering the tab over the vertical side of the jamb, the jamb can be plumbed and leveled to ease the installation of the jamb.

The slotted assembly of Applicant's claims, then, is distinct from the pivotally attached braces taught in Schaefer. That is, Schaefer's braces are attached on either end to the horizontal component and the vertical component such that the angle of attachment can be altered. However, Applicant's slotted assembly is not attached to the horizontal component, and serves to plumb and level the jamb. Accordingly, Schaefer's braces have a different configuration and function from the slotted assembly claimed by Applicant.

As Schaefer does not teach or suggest all of the elements set forth in Applicant's claimed invention, a prima facie case of obviousness has not been established for these claims. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Claims 5 and 14 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Schaefer in view of U.S. Patent No. 6,615,500 to Hale et al. ("Hale"). Applicant respectfully traverses this rejection.

Claim 5 depends from Claim 1, and therefore, includes all of the limitations contained in Claim 1. As previously discussed Schaefer does not teach or suggest all of the limitations contained in Claim 1. Nor has the Examiner argued that Hale cures this deficiency. Therefore, as neither Schaefer nor Hale, either alone or in combination, teach or suggest all of the limitations set forth in Claim 5, a prima facie case of obviousness has not been established for this claim. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Claim 14 depends from Claim 10, and therefore, includes all of the limitations contained in Claim 1. As previously discussed Schaefer does not teach or suggest all of the limitations contained in Claim 1. Nor has the Examiner argued that Hale cures this deficiency. Therefore, as neither Schaefer nor Hale, either alone or in combination, teach or suggest all of the limitations set forth in Claim 14, a prima facie case of obviousness has not been established for this claim. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.


New Claims 21-23

Claims 21-23 have been added to set forth a level comprising a mounting means. The mounting means comprises a horizontal component comprising an adjustable length so that the level may be mounted to differently dimensioned jambs. The mounting means further comprises a slotted assembly that not only secures the level to the jamb, but also allows the jamb to which the level is attached to be continuously plumbed and leveled even when the jamb is installed in a wall. Claims 21-23 are novel and non-obviousness over the prior art in general, and over Schaefer in particular, as the combination tool taught in Schaefer does not teach or suggest a means for mounting the combination tool as is claimed by Applicant.

In light of the foregoing remarks, reconsideration by the Examiner is respectfully requested. It is believed that the foregoing remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicant.

Respectfully submitted,

DOHERTY, WALLACE, PILLSBURY &
MURPHY, P.C.

By 

Deborah A. Basile
Customer No. 42,325
Registration No. 35,439

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